

**REMARKS**

After entry of the instant Amendment, claims 1-4, 6-10, 12, 13, and 15-18 are pending in the instant application with claim 1 in independent form. Independent claim 1 has been amended to incorporate the elements of dependent claim 5 therein. Dependent claims 5 and 14 have been cancelled in view of the amendment to independent claim 1. Claim 11 is also cancelled. No claims are presently added. The Applicants respectfully submit that no new matter is added through the instant amendments to the claims.

In the instant Office Action, claim 11 has been rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1-4, 7-10, 12-14, and 16-18 stand rejected under 35 USC §103(a) as being unpatentable over Morita et al. (PCT Pub. No. WO03/072656). Dependent claim 5 stands rejected under 35 USC §103(a) as being unpatentable over Morita et al. in view of Kuwabara et al. (US Pre-Grant Pub. No. 2003/0010962). Claims 1 and 5 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over co-pending U.S. App. Serial No. 11/912,631. Dependent claims 6 and 15 are objected to as depending from a rejected base claim, but would otherwise be allowable if rewritten in independent form.

In view of the cancellation of dependent claim 11, the Applicants respectfully submit that the rejection under 35 USC §112 of this claim is moot. Further, the Applicants respectfully submit that in view of the incorporation of the elements of dependent claim 5 into independent claim 1, the rejections under 35 USC §103(a) over Morita et al. alone are overcome and must be

withdrawn. As such, the only remaining rejection is that of dependent claim 5 under 35 USC §103(a) over Morita et al. in view of Kuwabara et al. The Applicants respectfully traverse the rejection of claim 5 under 35 USC §103(a) over Morita et al. in view of Kuwabara et al., as this rejection is now applied to amended independent claim 1. In particular, the Applicants respectfully submit that one of skill in the art, with knowledge of the teachings of Morita et al., would not reasonably have been expected to arrive at the invention as now claimed in amended independent claim 1 based upon the additional teachings contained in Kuwabara et al.

**Rejection of Claim 5 Under 35 USC §103(a) Over Morita et al. and Kuwabara et al., as Applied to Amended Independent Claim 1**

The Applicants respectfully submit that it would **not** be obvious to a person of ordinary skill in the art to modify the compositions of Morita et al. by adding the phenolic polysiloxanes taught by Kuwabara et al. to find a teaching in the prior art of curable silicone composition as claimed in the instant independent claim 1 as amended. As the Examiner is aware, *Graham v. John Deere* provides the basic framework for performing the obviousness inquiry, and the Supreme Court has recently reaffirmed the standards set forth in *Graham v. John Deere* in the decision of *KSR International Co. v. Tele-flex Inc. (KSR)*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007). In the wake of *KSR*, it is clear that many established tests that have been used in the past to prove or disprove obviousness of claims, while still useful to perform the obviousness inquiry, cannot be rigidly applied. MPEP 2141(II.) rightly summarizes the more global approach that is to be taken with regard to the obviousness inquiry in the wake of *KSR* by indicating that “the focus when making a determination of obviousness should be on what a

person of ordinary skill in the pertinent art **would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge”** (emphasis added).

The Applicants concur that the Examiner has faithfully applied the standards set forth in *Graham v. John Deere* relative to analysis of the instant claims in view of the teachings of Morita et al. and Kuwabara et al. However, the Applicants respectfully submit that the Examiner's conclusions do not reflect the actual knowledge that one of skill in the art would have gained from the combined teachings of Morita et al. and Kuwabara et al. such that one of skill in the art would not have modified Morita et al. based on the teachings of Kuwabara et al. in the manner necessary to arrive at the invention claimed in independent claim 1 as amended. The basis of the Applicants' position are as follows: 1.) Morita et al. and Kuwabara et al. are concerned with substantially different applications of the compositions taught therein, 2.) the phenolic resins of Morita et al. are of a different basic structure than the phenolic resins of Kuwabara et al. that the Examiner has equated, and 3.) the respective roles of the phenolic resins in Morita et al. and Kuwabara et al. are different. The Applicants respectfully submit that the sum of the three considerations summarized by 1.)-3.) prove that one of skill in the art would not have reasonably expected to have been able to practice the invention claimed in the instant independent claim 1 as amended based upon the combined teachings of Morita et al. and Kuwabara et al. The Applicants provide more detail below on each of the arguments summarized by 1.)-3.).

**1.) Morita et al. and Kuwabara et al. are concerned with substantially different applications**

A basic comparison of the intended applications of the compositions of Morita et al. and Kuwabara et al. reveals stark contrasts. Whereas Morita et al. is indicated as preparing **electrical or electronic element sealing resin compositions, pain, coating agents, and adhesives** due to flowability properties prior to curing and flame retarding properties after curing (see paragraph [0047] of Morita et al.), Kuwabara et al. is primarily concerned with a composition that can be used for bonding optical elements in optical isolators and other optical devices. Bonding and impact strength properties of the composition of Kuwabara et al. are of utmost importance, including the ability of the composition to form bonds that remain intact under hot humid conditions or thermal cycling conditions (see paragraph [0007] on page 1 of Kuwabara et al.), whereas flame retardance is the focus of the compositions of Morita et al. (due to the intended electrical applications for the compositions of Morita et al.). Such disparate important properties of the respective compositions would clearly be considered by a person of skill in the art when making determinations as to whether to include components from one composition in the other of the compositions. This is especially true when it is considered that there are no teachings in the respective references as to whether a given component could perform adequately for purposes of the important properties of the other of the respective references.

In further support of the above, flame retardant properties are mentioned as an important property in paragraph [0031] on page 13 of Morita et al., wherein certain phenolic resins are

described as preferred due to superior flame retardant properties of the cured products obtained with the composition including the phenolic resins. As such, the phenolic resins themselves of Morita et al. play a significant role in providing the desired flame retardant properties of the cured products obtained, and one of skill in the art attempting to supplement the teachings of Morita et al. would clearly consider flame retardant properties of alternative phenolic resins when determining the suitability thereof for use in the composition of Morita et al. Absent any guidance in Kuwabara et al. as to flame retardant properties of the phenolic resins taught therein, the Applicants respectfully submit that there is no basis for finding that a person of skill in the art would reasonably have been expected to supplement the composition of Morita et al. with the phenolic resins taught by Kuwabara et al.

**2.) The Phenolic Resins of Morita et al. are of a Different Basic Structure than the Phenolic Resins of Kuwabara et al.**

Notwithstanding the arguments set forth above relative to the stark contrasts in applications for which the respective compositions of Morita et al. and Kuwabara et al. are intended, the Applicants also submit that the basic structure of the phenolic resins taught in the respective references are different such that one of skill in the art would not have known to substitute one for the other, especially in view of the importance Morita et al. places upon flame retardance attributable to the phenolic resins taught therein.

To explain, Morita et al. describe suitable phenolic resins in paragraph [0031] thereof. The lengthy list of suitable types of phenolic resins in Morita et al. **noticeably excludes** resins having siloxanes in the main chains thereof. However, Morita et al. expressly addresses the

possibility of siloxanes being present in the resins described therein, **but only in the context of groups that are chemically bonded to the resins** (see lines 18 and 19 on page 13, paragraph [0031] of Morita et al.). Such description clearly does not encompass resins that include siloxanes in the main chain of the resin. Conversely, the phenolic resins taught by Kuwabara et al. **all have siloxane bonds in the main chain of the phenolic resins taught therein**, as evidenced by the general structures for the phenolic resins set forth at the top of page 3 of Kuwabara et al.

In view of the differences between the phenolic resins taught by Morita et al. and Kuwabara et al., coupled with the fact that the phenolic resins of Kuwabara et al. **are not even included in any of the broad groups of suitable phenolic resins taught by Morita et al.**, the Applicants respectfully submit that one of skill in the art clearly would not have chosen to include the phenolic resins of Kuwabara et al. in the composition of Morita et al. This is especially the case because Morita et al. provides descriptions of various phenolic resins that encompass countless different phenolic resins, any of which would be suitable for the invention thereof, and there is nothing with Kuwabara et al. to suggest that the specific phenolic resins taught therein would even be a suitable alternative to the phenolic resins of Morita et al.

**3. The Respective Roles of the Phenolic Resins of Morita et al. and Kuwabara et al. are Different**

As alluded to above in the preceding paragraphs, the Applicants respectfully submit that the roles of the respective phenolic resins of Morita et al. and Kuwabara et al. are different such that one of skill in the art would not have been taught to include the phenolic resins of

Kuwabara et al. in the compositions of Morita et al. merely based upon the fact that Morita et al. teaches the inclusion of a phenolic resin in the composition taught therein. As set forth above, Morita et al. teaches inclusion of phenolic resins therein with certain phenolic resins being desirable due to flame retardant properties thereof. However, Morita et al. generally discloses the compositions taught therein to have low melt viscosity and excellent reactivity and dispersibility in organic resins to thereby form a cured resin of excellent moldability and superior flame retardant properties (see paragraph [0005] on page 2 of Morita et al.).

Kuwabara et al. is not concerned with any of the important properties set forth in Morita et al. for either the phenolic resins taught therein or the compositions taught therein in general. In particular, Kuwabara et al. is concerned with providing an adhesive that can adequately bond optical elements, with the adhesive capable of forming a bond which remains intact under hot humid conditions or thermal cycling conditions and is impact resistant (see paragraph [0007] on page 1 of Kuwabara et al.). Such considerations are drastically different from the considerations set forth in Morita et al. for the compositions taught therein.

**4. The Logical Conclusion Drawn by Weighing 1.)-3.) Above is that a Person of Skill in the Art, With Knowledge of Morita et al., Would Not Reasonably Have Been Expected to Practice the Invention Claimed in Independent Claim 1 of the Instant Claims Based Upon the Teachings of Kuwabara et al.**

The Applicants respectfully reassert that the ultimate question is whether a person of skill in the art, with knowledge of the teachings of Morita et al, would reasonably be expected to arrive at the instant invention based upon other teachings in the art (in this case, the teachings of

Kuwabara et al.). The Applicants respectfully submit that the only conclusion that can be reached, in view of the above arguments set forth in I.)-3.) above, is that a person of skill in the art, with knowledge of Morita et al., would not reasonably have been expected to arrive at the instant invention based upon the teachings of Kuwabara et al.

In view of the foregoing, the Applicants respectfully submit that the rejections of dependent claim 5 under 35 USC §103(a) over Morita et al. in view of Kuwabara et al., as they now apply to independent claim 1, are overcome and must be withdrawn.

**Rejection of Claim 8 under Obviousness-type Double Patenting Over the '631 Application**

The Applicants continue to request that this rejection be held in abeyance until there is an indication of allowable subject matter in the instant application.

The Applicants respectfully submit that the instant claims are in condition for allowance and respectfully request such allowance. This Response is filed timely such that no fees are presently due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2789 in the name of Howard & Howard.

**Respectfully submitted,**

**HOWARD & HOWARD ATTORNEYS**

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Date

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